

Supreme Court, U. S.
FILED

MAY 18 1977

MICHAEL KODAK, JR., CLERK

In the
Supreme Court of the United States

OCTOBER TERM, 1976

—
No. 76-1442
—

A. G. SPALDING & BROS., INC.,
and QUESTOR CORPORATION,
PETITIONERS,

v.

PAUL SULLIVAN SPORTS, INC.,
RESPONDENTS.

REPLY BRIEF FOR PETITIONER

ROBERT B. RUSSELL
RUSSELL & NIELDS
One Boston Place
Boston, Massachusetts 02108
(617) 227-3835
Attorneys for Petitioners

In the
Supreme Court of the United States

OCTOBER TERM, 1976

No. 76-1442

A. G. SPALDING & BROS., INC.,
and QUESTOR CORPORATION,
PETITIONERS,

v.

PAUL SULLIVAN SPORTS, INC.,
RESPONDENTS.

REPLY BRIEF FOR PETITIONER

Petitioner replies to Respondent's Brief as follows:

I. THE DECISION BELOW CREATES A CONFLICT BETWEEN CIRCUITS

Respondent cites cases showing that the rule of law which requires the use of the same factual standard for the issue of validity and infringement, is no different in the First Circuit than it is in other Circuits. We agree that this was true before the case at bar. In the case at bar, however,

the lower Court very clearly used one standard while deciding infringement—a standard by which the Court was able to treat large differences in relative dimensions as being “routine engineering” in order to find infringement, but when deciding validity, to treat small differences of relative dimensions, of substantially less degree, as being “fundamental” and inventive in order to arrive at a holding of validity. This was inconsistent not only on the facts of the case at bar, but also inconsistent with the rule of law established by previously decided cases both in the First Circuit and in other Circuits. Thus, the case at bar establishes a new rule of law in the First Circuit and *creates* the conflict which Petitioner prays this Court to resolve.

The *Lerner* and *Ellman* case cited at pages 4 and 9 of the Petition, which sets forth this rule of law in the Second Circuit, has been published at 193 USPQ 329 (1977).

Petitioner has been unable to find a case wherein this Court has mentioned this rule of law. The ancient “nose of wax” case *White v. Dunbar*, 119 US 47 (1889), has been misquoted as so holding, but in fact, it does not. Therefore, an additional reason for granting this Petition is to permit this Court to place its stamp of approval on the rule and to caution Courts such as the lower Courts in the case at bar to take it seriously.

II. THE ILLUSTRATIONS PETITIONER HAS USED ARE EMPLOYED ONLY SHOW THE RELATIVE DIMENSIONS OF THE RESPECTIVE STRUCTURES, NOT THE LINEAR DIMENSIONS AS RESPONDENT IMPLIES

Respondent takes us to task for reproducing in the Petition the illustration of Palmer’s Figs. 7 and 8 taken from Exhibit SS (see Appendix p. 97). Respondent says this is false because actual linear dimensions appear on the

drawings in Exhibit SS, whereas there are no linear dimensions given in the Palmer patent.

We agree that the Palmer patent does not disclose linear dimensions. The Court will note, however, that at no time in the Petition do we refer to the linear dimensions appearing in the illustrations taken from Exhibit SS. We speak only of the *relative* dimensions. In fact, the claim is concerned only with *relative* dimensions, and, therefore, whether or not Palmer disclosed actual linear dimensions is irrelevant. Respondent’s contention about linear dimensions is, therefore, off the point and merely draws attention away from the real issue which deals with the relative dimensions, which can be seen without difficulty either in the illustrations we use or in the illustrations at page 4 of Respondent’s Brief. There is no material difference between the two. Respondent’s illustrations may not be quite as clear as Petitioner’s. Respondent’s illustrations include the usual cross-hatching and shading of patent drawings which tends somewhat to draw attention away from the basic contour of the various cross-sections. The presence or absence of the cross-hatching and shading, however, does not change the fact that the basic contours and relative dimensions of the cross-section of the extrusions are the same in Petitioner’s illustrations as in Respondent’s.

Accordingly, Respondent’s illustrations are as good as Petitioner’s “false” ones for demonstrating that the lower Courts in the case at bar have applied different factual standards for the respective issues of validity and infringement.

Respectfully submitted,

ROBERT B. RUSSELL

RUSSELL & NIELDS

One Boston Place

Boston, Massachusetts 02108

(617) 227-3835

Attorneys for Petitioners